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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,229	05/25/2001	Donald R. Youell JR.	ACP 2-021	2603

7590 10/23/2002

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EXAMINER

DURAND, PAUL R

ART UNIT PAPER NUMBER

3721

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/865,229

Applicant(s)

YOUELL ET AL.

Examiner

Paul Durand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 6-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of invention I in Paper No. 3 is acknowledged. The traversal is on the ground(s) that the examiner has not established that there is a serious burden in examining the cancelled claims. This is not found persuasive because per MPEP § 803.01 "For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant". In this instance, as detailed in the previous office action in paragraph nine, the examiner has shown serious burden by way of the inventions having acquired a separate status in the art as shown by their different classifications.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 6-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 3.

### ***Drawings***

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3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: all reference numbers in the specification are missing in the drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the method step is comprised of steps "a", "b" and "b".

Claims 1, 2 recites the limitation "said paperboard laminate". There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "said an automobile part product" in line 5. There is insufficient antecedent basis for this limitation in the claim.

In claim 3, the phrase " parts are ...or glass." renders the claim vague and indefinite. It is suggested that the claim be changed to read "part is selected from the group consisting of metal, composite, glass or combinations thereof."

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In claim 4, the phrase "parts are ...or fender" renders the claim vague and indefinite. It is suggested that the claim be changed to read "part is selected from a group consisting of window glass, door panel, hood, fender or combinations thereof.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Engles Jr. (US 3,154,898).

Engles discloses the invention as claimed including the method of providing a foam backing board 14 (Engle discloses that it is well known in the prior art to utilize a backing comprised of paperboard), having a front and back, placing an automobile part 10, comprised of metal and glass, on the board 14 leaving exposed areas on the front and shrink wrapping with plastic shrink wrap 16 onto the automobile part and exposed areas of front of the paperboard laminate (see Figs. 1-3, C1, L15-18 and C2, L59-69).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engles Jr.

Article 10 in Engles clearly discloses an automotive part. The examiner takes Official Notice that it is old and well known to package various types of automotive parts for the purpose of protecting the part from damage. Furthermore, nothing disclosed by the applicant makes packaging a specific article patentably distinct from the generic article. Therefore, it would have been obvious to one having ordinary skill in the art to have provided the invention of Engles with an automotive part including one or more of window glass, door panel, fender or hood for the purpose of protecting the part during shipping.

10. Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engles Jr. in view of Gillio-tos et al (US 4,611,456).

In regard to claim 2, Engles discloses the invention substantially as claimed including a paperboard back. What Engles does not disclose is the backing being comprised of a laminate. However, Gillio-tos discloses that it is old and well known in the art to use a backing 1, that can be comprised of a laminate as a means of increasing product durability (See Figs. 8,9 and C3, L20-23). Therefore it would have been obvious to one having ordinary skill in the art to have provided the invention of Engles with a laminate backing as taught by Gillio-tos for the purpose of increasing product durability.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engles Jr. in view of Wilikinson (US 6,010,003).

Engles discloses the invention substantially as claimed except for the method of placing the shrink wrapped packages in a box or container. However, Wilkinson teaches that it is old and well known in the art to place an object "O" that has been shrink wrapped to a backing with wrap 172, in a container "C" for the purposes of protecting the item during shipping (See Figs. 16 and 17). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the invention of Engle with a shipping container as taught by Wilkinson for the purpose of protecting the items during shipping.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rissberger, Carson, Stoker, Goodman, Larson, Kraut, Farquhar, Saltzer, Lidgard, Fales et al, Perbet et al, Havens et al, Puett, Garwood, Pollacco, and Chandler have been cited to show devices having similar structure.

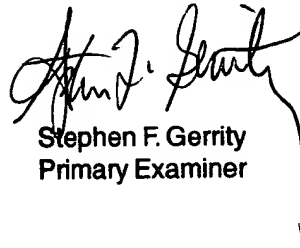
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 703-305-4962. The examiner can normally be reached on 0700-1730, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Paul Durand  
October 15, 2002



Stephen F. Gerrity  
Primary Examiner